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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,660	09/30/2003	Timothy M. Simon	CHOND.65023	5821

22859 7590 08/17/2006

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EXAMINER

WILLSE, DAVID H

ART UNIT PAPER NUMBER

3738

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,660

Applicant(s)

SIMON ET AL.

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The Applicant has traversed the finality of the Office action mailed on March 22, 2006, and the Applicant's arguments are persuasive regarding this matter. The finality of said Office action is therefore hereby vacated.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 13, 15, 16, 21-23, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Jansson et al., WO 98/52498 A1. Spaced rodlets 1 on the outer periphery define a plurality of ridges (Figure 1), and a lubricious surface is formed at both ends in embodiments comprising agar or gelatine, for example (Derwent abstract, line 7). Regarding claim 13, the ridge planes are substantially perpendicular to a central axis along a transverse cross-section bisecting the cylindrical surface of the pre-formed mass. Regarding claim 15, the ridges are discontinuous in that they each comprise rodlets which "are preferably of spherical or cylindrical sub-units" (Derwent abstract, lines 4-5). Regarding claims 22 and 23, the "approximately identical spaced (3) units" (Derwent abstract, line 3; Figure 1) define bores.

Claims 12, 13, 15, 16, 18, 21, 24, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Oka et al., JP 6-339490 A. Figure 4 illustrates a plurality of ridges formed

about a lower or distal portion of the outermost periphery. Since the articular bearing surface 7 is of a polyvinyl alcohol water-bearing gel 6 (JPO English abstract, lines 11-13), there are lubricious surfaces at both ends of the artificial articular cartilage 1. Regarding claim 15, the ridges are discontinuous because they are of fiber meshes (Figure 4; JPO English abstract).

Claims 14, 17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oka et al., JP 6-339490 A. Regarding claim 14, an artificial articular cartilage with a threaded (ridged) surface was well known in the art at the time of the present invention and would have been obvious in order to improve the anchorage into bone, particularly prior to osseointegration, with further motivation have been provided by the last sentence of the JPO English abstract. Regarding claim 17, polyhedral shapes were likewise common in the art and would have been obvious in order to better resist torsional forces. Regarding claim 19, tapered threaded and/or root surfaces would have been an obvious modification in order to enhance self-tapping and/or frictional engagement into the bone, as known to the ordinary practitioner. Regarding claim 20, barb-shaped threads would have been obvious to one of ordinary skill in order to impart a locking function to the implant.

Claims 12-14, 16, 18, 21, 22, 24, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Stone et al., US 5,306,311, which discloses a lubricious surface (column 7, lines 49-53) and a plurality of ridges (e.g., column 6, lines 3-16). Regarding claim 25: column 3, lines 15-17.

Claims 15, 17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone et al., US 5,306,311. Regarding claims 15 and 20, discontinuous ridges with a barb shaped cross-section would have been an obvious modification to the ordinary practitioner in order to

facilitate self-tapping and locking into the bone, with further motivation having been provided by the previously cited passage at column 6, lines 3-16. Regarding claim 17, a polyhedral shape would have been obvious in order to better resist torsion.

The Applicant's remarks have been considered. The original specification (of parent U.S. application serial no. 09/525,437) sets forth numerous definitions of terms (page 16 through 20), but "ridge" and "outermost periphery" are not among them. Regarding Jansson et al., the Applicant apparently asserts that the spaced rodlets 1 on the outer periphery "[do] not rise to the level of ridges as presently claimed" (Applicant's reply of July 27, 2006: page 2, lines 18-20). The term "ridge" is defined as "[a] long, narrow, or crested part of the body" (*Webster's II New Riverside University Dictionary*, 1984), and the rodlets 1 are certainly long and narrow portions of the body. The claims must be given their broadest reasonable interpretation (MPEP § 2111), and "[i]t is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language" (MPEP § 2111.01). The word "periphery" is defined as "the external boundary or surface of a body" (*Merriam Webster's Collegiate Dictionary*, 10th edition, 1996). The claimed expression "outermost periphery" is thus broad enough to encompass the entire outer surface of a body as well as surface portions that are "outermost" relative to a particular dimension (such as the radial dimension suggested by the Applicant's elongate forms depicted in Figures 3, 4, and 7). The Applicant's claims are unspecific as to any particular plug dimension for characterizing the "periphery", and cylindrical, frusto-conical, or other such surfaces are not even recited in the independent claims and several dependent claims, so the examiner need not interpret the outermost periphery as being "the plug's widest portion" (page 3, lines 14-15, of said reply). The Oka et al. ridges are formed

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about a portion of the entire three-dimensional outer surface or periphery and are formed about a surface or periphery that is outermost relative to the inferior direction of the tibial component.

Similar reasoning applies to the Stone et al. patent.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762 and who is generally available Monday through Thursday and sometimes on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Dave Willse
Primary Examiner
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